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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,706

01/08/2007

Saskia Lehmann

OST-061103

2066

22876 7590 11/23/2010
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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1765

MAIL DATE

DELIVERY MODE

11/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,706	Applicant(s) LEHMANN ET AL.	
	Examiner ROBERT SELLERS	Art Unit 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-11 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is responsive to the Request for Continued Examination and amendment filed September 24, 2010.

1. The issues regarding claims 24-27 and the 35 U.S.C. 112, second paragraph, rejection set forth in the Final rejection mailed June 25, 2010 on pages 2-4 have been resolved by the cancellation of the aforementioned claims.
2. The 35 U.S.C. 102(e) rejection over Xu Publication No. 2007/0149667, European Patent No. 1,086,403 and Oka et al. Patent No. 6,485,885 set forth on pages 7 and 8 of the Final rejection has been addressed by the deletion of claim 17.

The texts of the basis for obviousness-type double patenting and sections 102(b), 102(e) and 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed December 18, 2000.

Claims 1, 4-11 and 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 12, 13, 15-17 and 24 of copending application no. 11/649,728 for the reasons of record set forth in the previous Office actions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1765

Claims 1, 4-11 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiyama et al. Patent No. 5,118,567 and Noguchi et al. Patent No. 5,476,752.

The rejection has been modified in response to the limitation of the other resin in independent claim 1 to a melamine acrylate, acid-modified polyester or epoxy acrylate as originally defined in cancelled claim 3. The arguments filed September 24, 2010 have been considered but are unpersuasive.

3. Komiyama et al. in column 7, Example 1, lines 57-62 shows Nakamura NK-ester EA-800 epoxy acrylate having a molecular weight of 730.
4. Noguchi et al. in column 6, lines 33-34 and 45-48 disclose ethylenically unsaturated monomers (ii) including (meth)acrylic acid esters of epoxy resins.
5. The epoxy acrylates of the prior art are prepared by the reaction of one mole of a diglycidyl ether of bisphenol A monomer with two moles of (meth)acrylic acid. The resulting structure is a monomeric epoxy resin terminated with two (meth)acryloyl groups, thereby falling within both the claimed UV hardening monomer and epoxy acrylate species of other resin.

Claims 1, 4-11 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 1,086,403 in view of Knell Patent No. 5,346,933 and Kamen et al. Patent No. 5,656,336.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed September 24, 2010 have been considered but are unpersuasive.

6. The Final rejection on page 9, the first paragraph indicated that Xu and Oka et al. do not recite the other resin limited to a melamine acrylate, acid-modified polyester or epoxy acrylate.

7. The European patent (page 15, Example 1, Table 1, Formula #'s 1-8 exhibit mixtures of Ebecryl 3700 bisphenol A diglycidyl ether diacrylate (page 15, line 5) within the claimed epoxy acrylate other resin and SR399 dipentaerythritol monohydroxypentaacrylate (page 15, line 7) within the claimed UV hardening monomer.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1765

rs
11/19/2010